

REMARKS

Upon entry of this amendment, claims 1-3, 5-10 and 12-13 are pending in this application and presented for examination. Claims 1, 3, 4, 8 and 13 stand rejected. Claims 4, 11 and 14-56 have been canceled by Applicants without forfeiting any right to pursue canceled subject matter in a subsequent divisional or continuation application. Claims 1, 3 and 13 have been amended. Attached hereto is a marked-up version of the changes made to the claims by the current amendment. The attached page is captioned "Version with markings to show changes made".

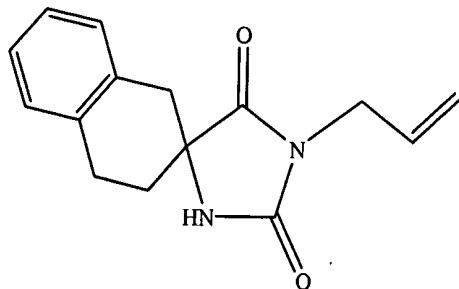
Reconsideration of the application is respectfully requested in view of the above amendments to the claims and the following remarks. For the Examiner's convenience and reference, Applicants' remarks are presented in the order in which the corresponding issues were raised in the Office Action.

Claim 1 has been amended to replace "optionally substituted (C₁-C₆)alkyl" with "optionally substituted ethyl, optionally substituted propyl, optionally substituted butyl", which are a (C₂)alkyl, (C₃)alkyl and (C₄)alkyl, respectively. This amendment finds support throughout the specification, specifically at page 7, lines 20-28.

Applicants believe no new matter is present in this or any other portion of the present amendment.

I. Election Requirement

Applicants note that amendments to the claims have removed the elected compound of Paper No. 10 from the scope of the claims. Accordingly, Applicants respectfully elect the following compound, 7,8-benzo-3-allyl-1,3-diazaspiro[4.5]decane-2,4-dione (BADD), see compound 7 in Table 1, and the description at page 7, lines 14-15 and page 20, lines 20-24. The elected species under 35 U.S.C. § 121, has the following structure:



II. Rejections under 35 U.S.C. § 112, 2nd paragraph

Claims 1, 3, 4, 8 and 13 have been rejected under 35 U.S.C. § 112, 2nd paragraph as allegedly failing to particularly point out and distinctly claim the subject matter of the present invention. To the extent the rejection is applicable to the amended set of claims, Applicants respectfully traverse the rejection.

The Examiner rejected claim 1 for allegedly using improper Markush language. Applicants respectfully point out that claim 1 has been amended to recite “Z is a member selected from the group consisting of optionally substituted (C₁-C₃)alkylene, C(O), and a single bond.” As this language is appropriate under MPEP § 2173.05(h), Applicants respectfully request that the rejection be withdrawn.

The Examiner further rejected claim 13 for allegedly failing to conform to MPEP § 608.01(m) for lacking a period at the end of the claim. Applicants respectfully note that claim 13 has been amended to include a period, thus signifying the end of the claim. Accordingly, Applicants respectfully request that the rejection be withdrawn.

III. Rejection under 35 U.S.C. § 102(b)

The Examiner rejected claims 1, 3, 4, 8 and 13 under 35 U.S.C. § 102(b) in view of Zussman *et al.* (U.S. Patent No. 4,091,223). The Examiner cites Example 2 at column 11 of Zussman *et al.* as allegedly anticipating the compounds of the present invention. To the extent the rejection is applicable to the amended set of claims, Applicants respectfully traverse the rejection.

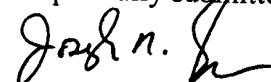
Claim 1 has been amended to set forth preferred alkyl groups for R¹ and R², i.e., ethyl, propyl and butyl. Claims 3 and 13 have been amended to conform with the amendments to claim 1. Applicants respectfully note that, following the amendments to the claims, the cited compound in Zussman *et al.* no longer falls within the scope of the claims. Accordingly, Applicants respectfully request that the rejection be withdrawn.

CONCLUSION

In view of the foregoing, Applicants believe all claims now pending in this Application are in condition for allowance. The issuance of a formal Notice of Allowance at an early date is respectfully requested.

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 925-472-5000.

Respectfully submitted,

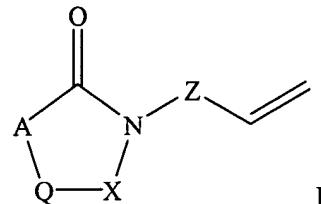


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VERSION WITH MARKINGS TO SHOW CHANGES MADE

1. (Amended) A compound having the formula:



wherein:

A is a member selected from the group consisting of NH, N-R⁸ and CR¹R², wherein R⁸ is a halogen;

R¹ and R², are each independently selected from the group consisting of [optionally substituted (C₁-C₆)alkyl]optionally substituted ethyl, optionally substituted propyl, optionally substituted butyl, optionally substituted (C₂-C₆)alkenyl, optionally substituted (C₂-C₆)alkynyl, optionally substituted cycloalkyl, optionally substituted (C₁-C₆)alkoxy, optionally substituted aryl and optionally substituted heteroaryl;

or, R¹ and R² and the carbon to which they are bound join to form an optionally substituted carbocyclic or optionally substituted heterocyclic ring;

Q is a member selected from the group consisting of C(O), NH, N-R⁹ and CR³R⁴, wherein R⁹ is a halogen;

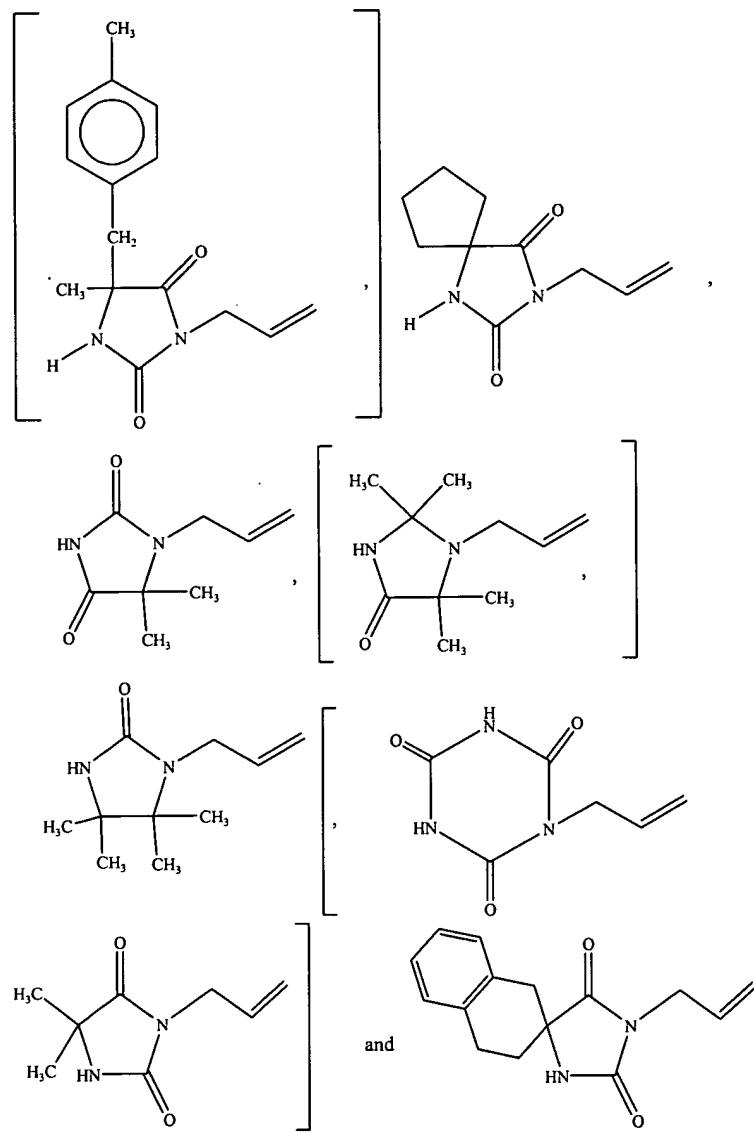
R³ and R⁴, are each independently selected from the group consisting of optionally substituted (C₁-C₆)alkyl, optionally substituted (C₂-C₆)alkenyl, optionally substituted (C₂-C₆)alkynyl, optionally substituted cycloalkyl, optionally substituted (C₁-C₆)alkoxy, optionally substituted aryl and optionally substituted heteroaryl;

or, R³ and R⁴ and the carbon to which they are bound join to form an optionally substituted carbocyclic or optionally substituted heterocyclic ring;

23 X is a member selected from the group consisting of C(O)[, C(O)-NR⁵] and CR⁶R⁷[,
24 **wherein R⁵ is a member selected from the group consisting of hydrogen,**
25 **halogen, optionally substituted (C₂-C₆)alkenyl and optionally substituted (C₁-**
26 **C₆)alkyl];**
27 R⁶ and R⁷, are each independently selected from the group consisting of optionally
28 substituted (C₁-C₆)alkyl, optionally substituted (C₂-C₆)alkenyl, optionally
29 substituted (C₂-C₆)alkynyl, optionally substituted cycloalkyl, optionally
30 substituted (C₁-C₆)alkoxy, optionally substituted aryl and optionally substituted
31 heteroaryl;
32 or, R⁶ and R⁷ and the carbon to which they are bound join to form an optionally
33 substituted carbocyclic or optionally substituted heterocyclic ring; and
34 Z is a member selected from the group consisting of optionally substituted (C₁-
35 C₃)alkylene, C(O), **[or]and** a single bond.

1 3. (Amended) The compound of claim 1, wherein: A is CR¹R², wherein R¹
2 and R², are each **[optionally substituted (C₁-C₆)alkyl]independently selected from the group**
3 **consisting of optionally substituted ethyl, optionally substituted propyl and optionally**
4 **substituted butyl.**

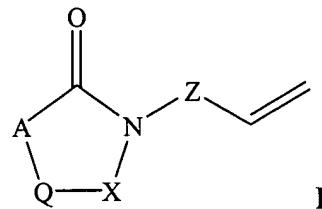
1 13. (Amended) The compound of claim 1, said compound is a member
2 selected from the group consisting of



APPENDIX A: PENDING CLAIMS

All claims pending, including those unchanged by the present amendment, are reproduced below for the convenience of the Examiner.

1 1. (Amended) A compound having the formula:



2 wherein:

3 4 A is a member selected from the group consisting of NH, N-R⁸ and CR¹R², wherein R⁸ is
5 5 a halogen;

6 6 R¹ and R², are each independently selected from the group consisting of optionally
7 7 substituted ethyl, optionally substituted propyl, optionally substituted butyl,
8 8 optionally substituted (C₂-C₆)alkenyl, optionally substituted (C₂-C₆)alkynyl,
9 9 optionally substituted cycloalkyl, optionally substituted (C₁-C₆)alkoxy, optionally
10 10 substituted aryl and optionally substituted heteroaryl;

11 11 or, R¹ and R² and the carbon to which they are bound join to form an optionally
12 12 substituted carbocyclic or optionally substituted heterocyclic ring;

13 13 Q is a member selected from the group consisting of C(O), NH, N-R⁹ and CR³R⁴,
14 14 wherein R⁹ is a halogen;

15 15 R³ and R⁴, are each independently selected from the group consisting of optionally
16 16 substituted (C₁-C₆)alkyl, optionally substituted (C₂-C₆)alkenyl, optionally
17 17 substituted (C₂-C₆)alkynyl, optionally substituted cycloalkyl, optionally
18 18 substituted (C₁-C₆)alkoxy, optionally substituted aryl and optionally substituted
19 19 heteroaryl;

20 or, R³ and R⁴ and the carbon to which they are bound join to form an optionally
21 substituted carbocyclic or optionally substituted heterocyclic ring;
22 X is a member selected from the group consisting of C(O) and CR⁶R⁷;
23 R⁶ and R⁷, are each independently selected from the group consisting of optionally
24 substituted (C₁-C₆)alkyl, optionally substituted (C₂-C₆)alkenyl, optionally
25 substituted (C₂-C₆)alkynyl, optionally substituted cycloalkyl, optionally
26 substituted (C₁-C₆)alkoxy, optionally substituted aryl and optionally substituted
27 heteroaryl;
28 or, R⁶ and R⁷ and the carbon to which they are bound join to form an optionally
29 substituted carbocyclic or optionally substituted heterocyclic ring; and
30 Z is a member selected from the group consisting of optionally substituted (C₁-
31 C₃)alkylene, C(O), and a single bond.

1 2. (Unchanged) The compound of claim 1, wherein: A is NH and Z is CH₂.

1 3. (Amended) The compound of claim 1, wherein: A is CR¹R², wherein R¹
2 and R², are each independently selected from the group consisting of optionally substituted ethyl,
3 optionally substituted propyl and optionally substituted butyl.

1 5. (Unchanged) The compound of claim 1, wherein: A is CR¹R², and
2 wherein R¹ and R² and the carbon to which they are bound join to form an optionally substituted
3 carbocyclic or optionally substituted heterocyclic ring.

1 6. (Unchanged) The compound of claim 5, wherein: R¹ and R² and the
2 carbon to which they are bound join to form an optionally substituted carbocyclic ring.

1 7. (Unchanged) The compound of claim 1, wherein: Q is C(O).

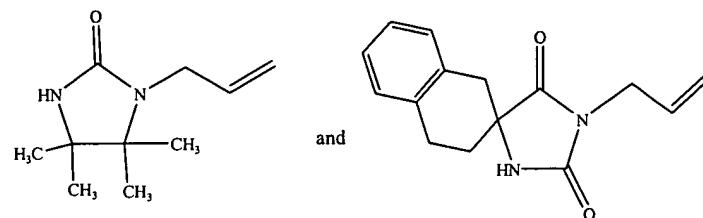
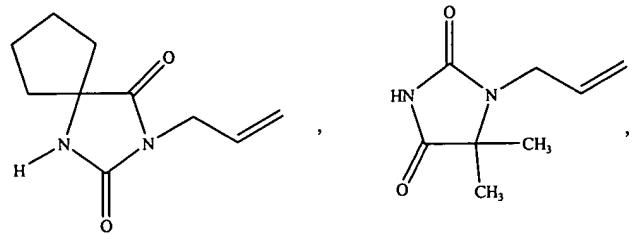
1 8. (Unchanged) The compound of claim 1, wherein: Q is NH.

1 9. (Unchanged) The compound of claim 1, wherein: Q is CR³R⁴, wherein R³
2 and R⁴, are each optionally substituted (C₁-C₆)alkyl.

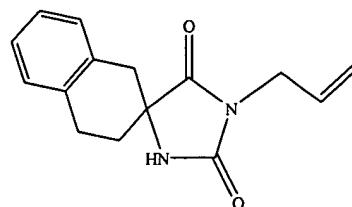
1 10. (Unchanged) The compound of claim 1, wherein: X is CR⁶R⁷, wherein R⁶
2 and R⁷, are each optionally substituted (C₁-C₆)alkyl.

1 12. (Unchanged) The compound of claim 1, wherein: Z is C(O).

1 13. (Amended) The compound of claim 1, said compound is a member
2 selected from the group consisting of



and



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